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CENTRAL FAX CENTER

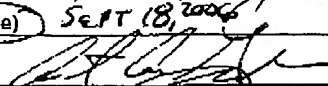
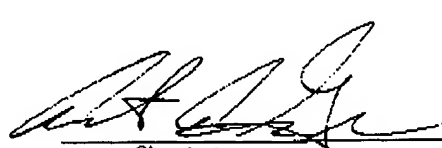
SEP 18 2006

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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 8C20.1-200 | |
|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--|------------------------------------------|---------------------------------|
| <p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on (via facsimile) <u>SEPT 18, 2006</u></p> <p>Signature <u></u></p> <p>Typed or printed Name <u>Arthur A. Gardner</u></p> | | Application Number 10/742,153 | Filed 12/19/03 |
| | | First Named Inventor ENZMANN, Mark J. | |
| | | Art Unit 2681 | Examiner DESIR, Pierre Louis |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>33,887</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number _____</p> <p> Signature <u>Arthur A. Gardner</u> Typed or printed name <u>770.984.2300</u> Telephone number <u>September 18, 2006</u> Date</p> | | | |
| <p><input type="checkbox"/> *Total of _____ forms are submitted.</p> | | | |

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**RECEIVED
CENTRAL FAX CENTER****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE****SEP 18 2006**

In re application of : ENZMANN Mark J.)

Serial No. 10/742,153)

Group Art Unit: 2617

Filed: December 19, 2003)

Examiner: DESIR, Pierre Louis

For: METHOD AND APPARATUS FOR)
PROVIDING SEAMLESS CALL HANDOFF)
BETWEEN NETWORKS THAT USE)
DISSIMILAR TRANSMISSION ELEMENTS)**PRE-APPEAL BRIEF REQUEST FOR REVIEW**Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
Fax: 571.273.8300

September 18, 2006

Sir:

This is a pre-appeal brief requesting further review. Please consider the remarks that follow. The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account Number **501513**. If any further extension of time is necessary, please consider this a request therefore.

PRE-APPEAL BRIEF REQUEST FOR REVIEWRECEIVED
CENTRAL FAX CENTER***Remaining Claims***

JUL 18 2006

Claims 1-17 remain pending in this application. As explained in more detail below, Applicant submits that all claims are in condition for allowance and respectfully requests such action.

Rejection of Claims 1 - 17 under 35 USC §102 – Jagadeesan et al.

Claims 1 - 17 are rejected under 35 USC §102(e) as being anticipated by Jagadeesan et al. (Pub No. US 20050059400).

Applicant respectfully traverses this rejection.

Applicant asserts that the inventor of the present application conceived and reduced the invention to practice in the United States prior to the effective date of the Jagadeesan et al. reference, which is believed to be September 12, 2003. On January 30, 2006, Applicant filed a 37 C.F.R. § 1.131 declaration with the USPTO, which is hereby incorporated in its entirety by reference, setting forth facts *sufficient* to show that the present invention was invented in the United States prior to the effective date of the cited reference. This brief will further clarify the exhibits that have been filed while explicitly pointing out particular facts established by such exhibits (an additional copy of the invention record has been attached to this reply to serve as a reference in establishing such facts—numbered pages 1-5).

Although evidence submitted by the Applicant regarding the Applicant's 37 C.F.R. § 1.131 declaration need not support all claimed limitations, the Applicant believes that at least all of the independent claims in the pending application are supported by the invention record. For example, the invention record clearly supports independent Claim 1:

A wireless device having both cellular capability and 802.1x capability, the wireless device comprising (*see page 2 of invention record—many PDA's already have both 802 and cellular data capabilities; and pages 3-5 text and figures—a wireless device with 802.11 and cellular capability*):

a signal strength detection circuit configured to detect when a strength of an 802.1x signal transmitted by an access point of an 802.1x network drops below a certain level and when a strength of a cellular signal transmitted by a cellular network is above a certain level (*see pages 3-4 text and figures—the wireless device is currently connected to the internet or an*

intranet via 802.11 architecture, the device has initiated a voice call to the terminating station over the 802.11 connection; the wireless device while currently connected to the terminating station over the 802.11 connection is moving out of range of the AP, in this case also out of range of the 802.11 connection, the device wishing to continue the connection will use the cellular capability to query the local service provider for capacity and capabilities); and

a handoff initiation circuit configured to initiate a handoff of a call from the 802.1x network to the cellular network (see page 5 text and figures—the wireless device will use the cellular query response to establish an IP connection to the local provider, the IP connection information to the server will be updated with the new IP addressing (similar to DNS updates) via the 802 connection and the voice connection will move to the newly established cellular IP connection, the 802 connection will be severed).

The invention record also clearly supports independent Claim 8:

A method for initiating a call handoff from a cellular network to an 802.1x network, the method being performed by a wireless device (*see page 2 of invention record—this invention describes a method to continue an in-progress communication across networks with dissimilar transmission methods including 802.11, cellular data specification, GPRS, 1XRT, 3XRT, EDGE, etc.; many PDA's already have both 802 and cellular data capabilities; and pages 3-5 text and figures—a wireless device with 802.11 and cellular capability*), the method comprising:

measuring the strength of a cellular signal being received by a wireless device from a cellular network;

determining whether the strength of the cellular signal has dropped below a certain level;

measuring a strength of an 802.1x signal being received by the wireless device from an access point of an 802.1x network;

determining whether the strength of the 802.1x signal is above a certain level (*see pages 3-4 text and figures—the wireless device is currently connected to the Internet or an intranet via 802.11 architecture, the device has initiated a voice call to the terminating station over the 802.11 connection; the wireless device while currently connected to the*

terminating station over the 802.11 connection is moving out of range of the AP, in this case also out of range of the 802.11 connection, the device wishing to continue the connection will use the cellular capability to query the local service provider for capacity and capabilities); and

wherein if the cellular signal strength is determined to be below a certain level and the 802.1x signal strength is determined to be above a certain level, performing a call handoff from the cellular network to the 802.1x network (see page 5 text and figures—the wireless device will use the cellular query response to establish an IP connection to the local provider, the IP connection information to the server will be updated with the new IP addressing (similar to DNS updates) via the 802 connection and the voice connection will move to the newly established cellular IP connection, the 802 connection will be severed)(See also page 2 of the invention record—the method is currently written with the call initiation occurring on the 802 leg but that is not to say that the reciprocal direction is not valid, a reversal of the steps would accomplish the transition from cellular data to 802).

Additionally, the invention record supports independent Claim 12:

An 802.1x network (see page 3—the wireless device is currently connected to the internet or an intranet via 802.11 architecture) comprising:

an access point (see pages 3-5 text and figures—AP (access point) local 802.11 connection server); and

a server (see pages 3-5 text and figures—SIP (or equivalent server), the server comprising logic configured to determine when a call handoff switch from the 802.1x network to a cellular network is to occur (see pages 3-5 text and figures—the wireless device is currently connected to the internet or an intranet via 802.11 architecture, the device has initiated a voice call to the terminating station over the 802.11 connection; the wireless device while currently connected to the terminating station over the 802.11 connection is moving out of range of the AP, in this case also out of range of the 802.11 connection, the device wishing to continue the connection will use the cellular capability to query the local service provider for capacity and capabilities, the wireless device will use the cellular query response to establish an IP connection to the local provider, the IP connection information to the server will be updated with the new IP addressing (similar to

DNS updates) via the 802 connection and the voice connection will move to the newly established cellular IP connection, the 802 connection will be severed) and to communicate with a media gateway (see pages 3-5 text and figures noting the connection between the SIP (or equivalent server) and the media gateway) to cause the call handoff switch to occur (see page 5 noting the connection between the wireless device and the terminating station has switched between 802 and cellular).

All other independent claims are very similar and are supported in the same or a similar manner as proposed above. As such, the Applicant believes that the invention record submitted with the Applicant's 1.131 declaration has sufficiently established facts necessary to prove that the Applicant had indeed conceived of the present invention at least as early as the filing date of the Jagadeesan reference.

The Examiner also has rejected the Applicant's submission of the 1.131 declaration by alleging that diligence from conception to reduction to practice has not been shown. Please reference pages 7-8 of the Applicant's "Response After Final" dated June 19, 2006 for the Applicant's broader argument concerning diligence. The Jagadeesan reference filing date is September 12, 2003. The Applicant's filing date is December 19, 2003. The Applicant has stated in his 1.131 declaration that the invention was conceived prior to the Jagadeesan filing date (Please see reference numeral 5 of the Applicant's 1.131 declaration filed January 19, 2006). Additionally, the Applicant has stated that the invention was conceived during his employment within a corporate entity and that it takes a finite amount of time to act upon an internally-made invention and then to file a patent application therefore (see reference numeral 6 of declaration). It can be appreciated that it takes a significant amount of time for a corporation to investigate a possible inventive concept, submit the idea to patent attorneys for the preparation of the application, and then prepare and file the actual patent application with multiple rounds of revisions and changes along the way. However, even in this specific situation, the Jagadeesan reference's filing date merely predates the Applicant's filing date by approximately 3 months.

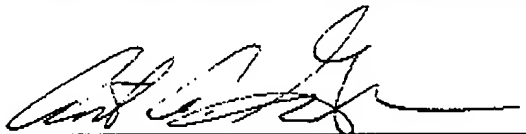
The Applicant has previously stated in a prior communication (June 19, Page 8) that the dates of the invention disclosure have been redacted, as the Applicant does not intend to make these dates a matter of public record. However, MPEP rule 715.07 clearly points out that under such circumstances, the Applicant may allege that the conception took

place prior to a specified date. The Applicant has done so in the 1.131 declaration by stating that conception took place at least as early as September 12, 2003. The Application was filed little more than 3 months after this date. Under MPEP 715.07(a) the critical period for showing diligence "begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice." Clearly, the Applicant's patent application was being prepared during this time period. Furthermore, a day-by-day accounting of the whereabouts of this application prior to filing is not appropriate or required by the MPEP and certainly is not available in this situation. Finally, the Examiner has not stated why diligence has not been shown other than a conclusory statement to that effect. Therefore, the Applicant feels that diligence has been shown properly and the application is in full condition for allowance.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that all pending claims are in condition for allowance, and Applicant requests a Notice of Allowance be issued in this case. Should there be any further questions or concerns, the Examiner is urged to telephone the undersigned to expedite prosecution.

Respectfully submitted,
GARDNER GROFF SANTOS & GREENWALD, P.C.



Arthur A. Gardner
Reg. No. 33,887

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| | |
|----------------------------|------------------|
| Disclosure No.: [REDACTED] | Date: [REDACTED] |
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Invention Disclosure Form

1. What can we call your invention? (10 words or less)

Call Handoff from dissimilar transports.

2. Who do you think contributed to the conception of your invention?

List yourself and the people who may be inventors. (Use additional sheets if necessary)

| | | |
|------------------------------------------------------------------------------------------------|----------------------------|------|
| Mark Enzmann | | |
| Name Printed | Signature | Date |
| Current Cingular Employee? <input checked="" type="checkbox"/> Yes <input type="checkbox"/> No | Network Strategic Planning | |
| | Business Unit | |
| (404)249-0723 | (404)236-5949 | |
| Telephone Number | Fax Number | |
| 5565 Glenridge Connector #960 | Atlanta, Ga 30342 | |
| Business Address | City, State, Zip | |

| | | |
|-------------------------------------------------------------------------------------|------------------|------|
| | | |
| Name Printed | Signature | Date |
| Current Cingular Employee? <input type="checkbox"/> Yes <input type="checkbox"/> No | Business Unit | |
| | | |
| Telephone Number | Fax Number | |
| | | |
| Business Address | City, State, Zip | |

| | | |
|-------------------------------------------------------------------------------------|------------------|------|
| | | |
| Name Printed | Signature | Date |
| Current Cingular Employee? <input type="checkbox"/> Yes <input type="checkbox"/> No | Business Unit | |
| | | |
| Telephone Number | Fax Number | |
| | | |
| Business Address | City, State, Zip | |

3. Who will be the point of contact for further information?

| | |
|-----------|---------------|
| Name: | Mark Enzmann |
| Telephone | (404)249-0723 |

URGENT
original
submission
date to CC.
L.B.

4. What is your invention? Please attach additional sheets (as much information as you feel is necessary) to describe your concepts - flow charts and/or block diagrams can be very helpful. In preparing this description, try to address the following:
- a) What have others done in the past (or, do now) - i.e. what is the problem that was solved?
 - b) What makes your invention new or different from what was done before - i.e. what is your solution?
 - c) What makes your invention better than what was done before?

This invention describes a method to continue an inprogress communication across networks with dissimilar transmission methods. In particular the involved networks would be 802.11 specification and Cellular data specification of any of the following: GPRS, 1XRT, 3XRT, EDGE, etc.

The method is currently written with the call initiation occuring on the 802 leg but that is not to say that the reciprical direction is not valid. A reversal of the steps would accomplish the transition from Cellular data to 802.

The attached visio diagrams give visual representation to the steps.

The technology used to accomplish this task is partially residing in the terminals and network today. There will be subtle changes in the sensing circuits of a terminal that has both 802 and cellular data capabilities incorporated. Many PDAs already have this ability. The kernel code envisioned is similar to code currently in use in cellular networks to aid in cell to cell handoff of a cellular voice call.

5. Two witnesses (who are not inventors) must attest to the fact that they read and understand the attached description. The Witnesses must sign below and initial and date each page of the attached description.

Witness Name

Signature

Date

Witness Name

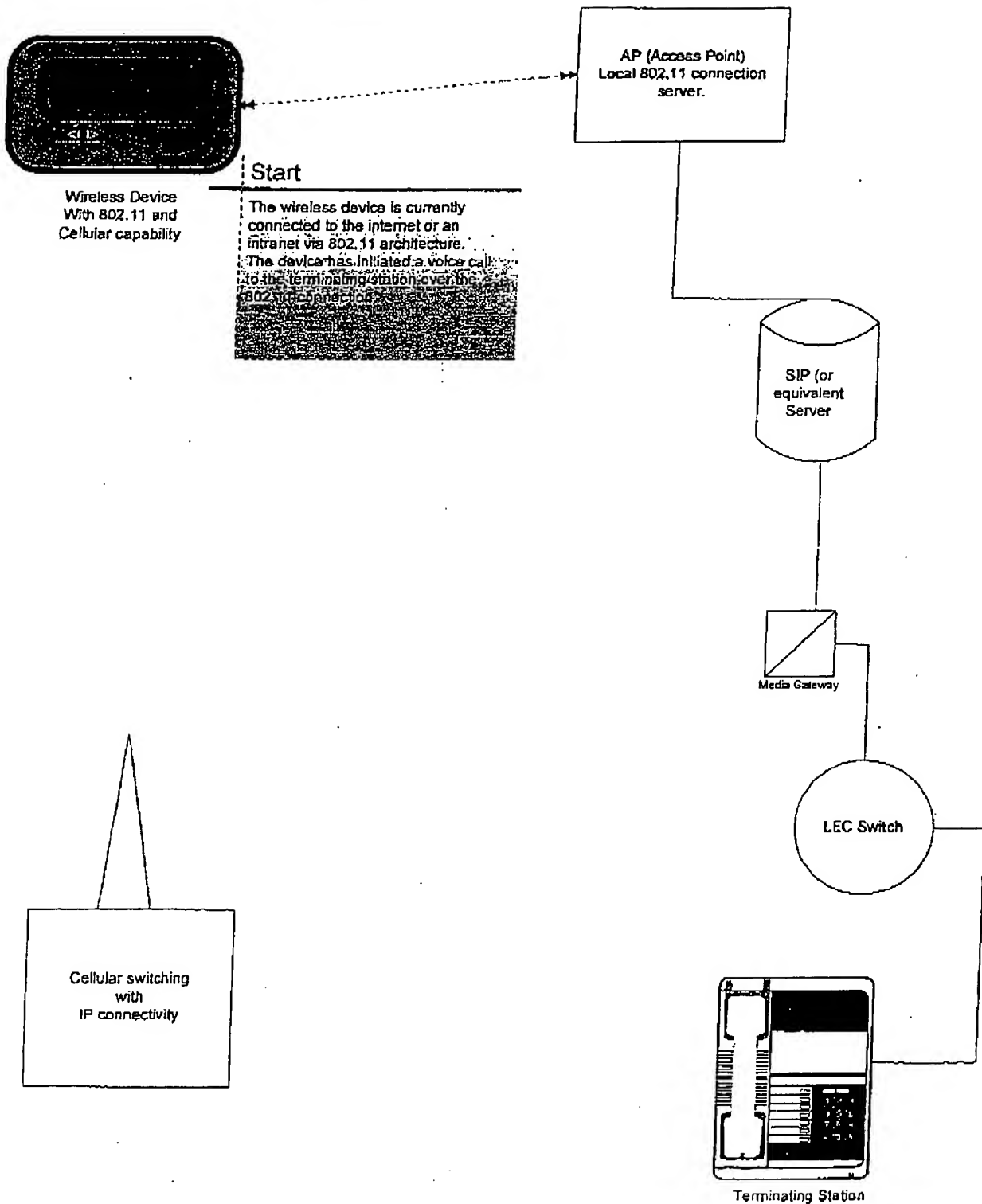
Signature

Date

E-mail this form and the Matrix to: <mailto:ipdisclosures@cingular.com>

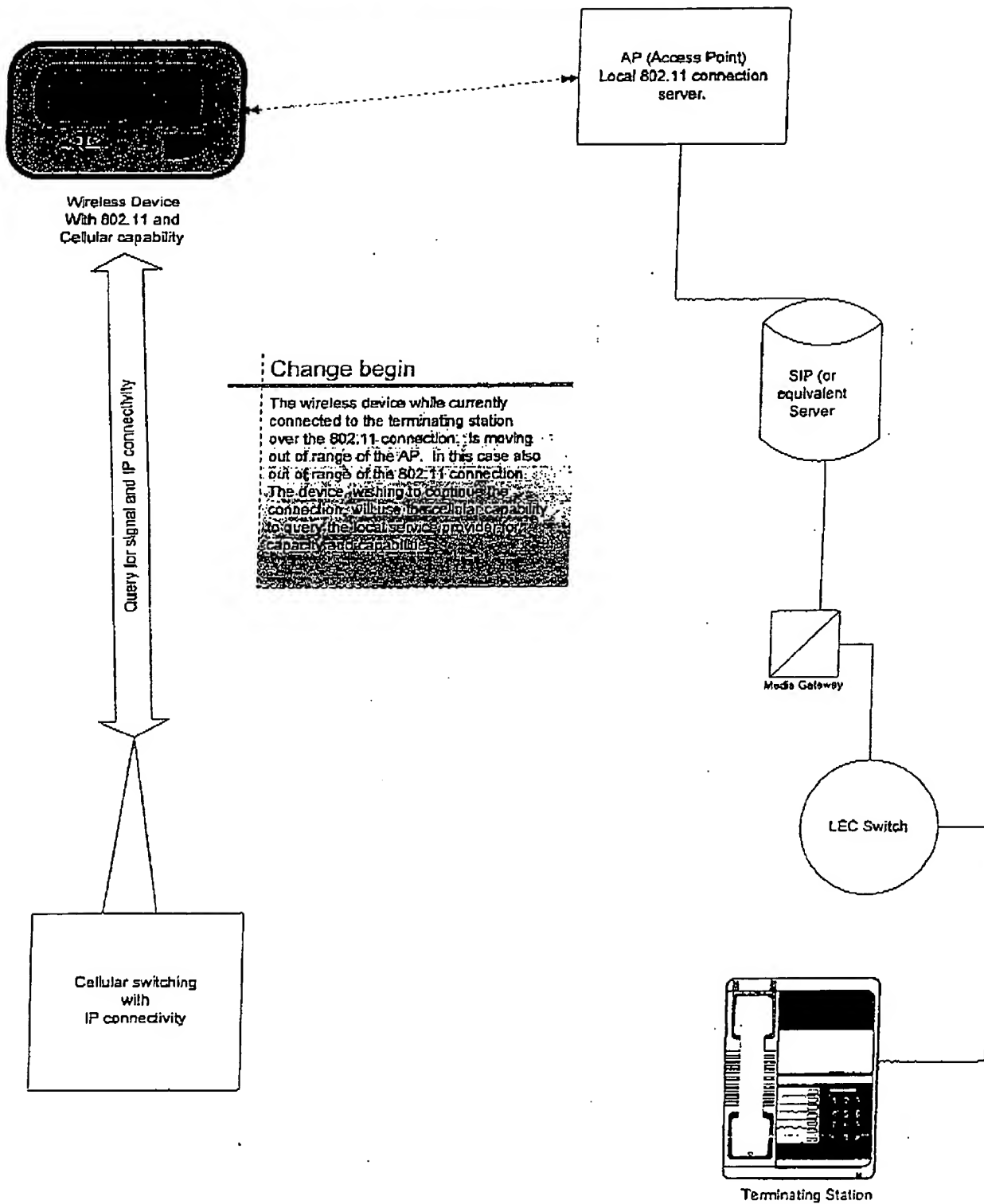
WIRELESS TERMINATION

STEP 1



Wireless Handoff

Step 2



Wireless Handoff

